

Application Serial No. 09/472,100

REMARKS

Claims 1-30 are rejected by the Examiner under 35 USC 103 as being unpatentable under Tedesco in view of Walker and "Hawaiian to offer tickets through ATMs." Applicant has previously discussed Tedesco and Walker. In view of the Examiner's indication in the Office Action (page 2, item number 4) that a new grounds of rejection are recited, Applicant takes the view that Applicant's previous comments with regard to Tedesco and Walker have persuaded the Examiner that that combination does not render the invention obvious under 35 USC 103. In this regard, Applicant takes the opportunity to point out that the Examiner referring to and the application being "anticipated" under 35 USC 103 is incorrect. Anticipation refers to novelty rejection under 35 USC 102. Applicant believes the Examiner meant to say that the invention is obvious in view of the combined references. However, as noted in the foregoing, it also appears that Applicant has overcome the Examiner's rejection for obviousness based on the combination of Walker and Tedesco. Again, Applicant repeats herein the arguments made with regard to Tedesco and Walker and notes that with regard to Hawaiian Air, that the full text of the reference is contained in four short paragraphs. The relevant portion appears to be the following:

Hawaiian Air said both customers and non-customers of Bank of Hawaii, a unit of Pacific Century Financial Corp., will be able to buy flight coupons through the bank's ATMs 24 hours a day, using cards issued by the bank or a major credit card. The coupons, essentially open tickets, will be available in quantities of one, two, four, or eight, will be valid for one year and will cost the same as those purchased from the airline or travel agency. Customers will need to contact Hawaiian Air to reserve space on their desired flight, the carrier said.

Before addressing the Hawaiian Air reference, Applicant also notes that the Examiner indicates that the "American Express student airline discount coupons" and "airline upgrade coupons" are further examples of prior art. However, the Examiner has not provided this art to the Applicant, so Applicant is unable to evaluate the relevance of this

Application Serial No. 09/472,100

art. Further, the Examiner appears to be taking Official Notice that "it is traditionally known (sic) that stores would be selling gift certificates to the patrons for the specific use in the store to be redeemed at the store that issued such certificate." If the Examiner is taking Official Notice of such facts as those contained in that statement, then the Examiner is asked to provide a declaration in support of such notice, as required by MPEP 2144.03.

With regard to Hawaiian Air, the reference teaches the person skilled in the art that one may use an ATM machine to buy an airline ticket. In the case of the Hawaiian Air reference, the airline ticket is merely a voucher for airline services that may be reserved independently of the act of buying the ticket. However, the Hawaiian Air reference teaches nothing more than the use of an ATM to make a purchase. This is no different than well-known use of a debit card to make a purchase because ATMs, in fact, use debit cards to make cash dispersals to the card holders. Thus, in the case of Hawaiian Air, the ATM is used as a debit card terminal. This has nothing to do with the claimed invention. The claimed invention involves a "virtual certificate." The invention also involves a "certificate issuance module for creation of an issue certificate upon selectable acquisition of said virtual certificate by an acquirer user at said client terminal..." Applicant cannot see how the direct purchase of an airline voucher at an ATM machine has anything to do with Applicant's claimed invention, which comprises both a virtual certificate and a certificate issuance module. Further, Applicant cannot see how Hawaiian Air has anything to do with the provision of a "module for authorization of an off-line redemption of said issued certificate at said redemption location to said holder of said issued certificate."

As Applicant has previously discussed, Tedesco is a check processing system. Applicant's invention has nothing to do with processing checks. Walker is only concerned with pre-funded certificates. Again, the invention has nothing to do with pre-funded certificates. To establish a *prima-facie* case of obviousness, the Examiner must show motivation to combine the references, a likelihood of success that the combined

Application Serial No. 09/472,100

references will produce the claimed invention, and each and every element of the claimed invention must be found among the cited references (MPEP 2142).

Here there is no motivation to combine the teachings or the references. In such cases where the motivation is not immediately apparent, it is the duty of the Examiner to explain why the combinations of teachings is proper. Applicant does not understand how a check processing system and a prepaid certificate would be combined by a person skilled in the art with an ATM system for purchasing airline vouchers to produce the claimed invention.

The following aspects of the claimed invention would require some explanation to the person skilled in the art in the combined references to motivate the skilled person to produce the invention:

1. There would have to be a certificate authority by which a virtual certificate could be defined through a seller terminal across a network.
2. There would have to be a certificate issuance module for creation of an issued certificate upon acquisition of the virtual certificate by an acquirer user at a client terminal across a network.
3. There would have to be a certificate authentication module for authorization of an off-line redemption of said issued certificate at said redemption location.

The three foregoing items comprise a system by which a virtual certificate may be obtained at a location and by which an issued certificate may be produced. These are two different certificates. The invention thus provides a virtual certificate and the certificate itself, which may be used at a point of sale. The virtual certificate is used to make a purchase for goods or services and the certificate produced therefrom is a physical representation of certificate that may be used as payment for the goods or services.

Application Serial No. 09/472,100

Applicant notes that the fact that references may be combined or modified is not sufficient to establish *prima-facie* obviousness.

Applicant also notes that there is no likelihood that the suggested references could be combined successfully to produce the claimed invention. Tedesco's checking system is not suited for combination with Walker's prepaid certificate system. Further, neither system is combinable with an ATM system as suggested by the Hawaiian Air reference. Thus, the skilled person would be unable to combine the teachings in the references to produce the claimed invention absent significant experimentation, which experimentation amounts to patentable invention.

Finally, the references do not teach each and every element of the claimed invention. As mentioned above, the concept of a virtual certificate and the issued certificate is not found in the art of record. The claimed invention provides a mechanism by which a virtual certificate may be subject to a transaction online from which an issued certificate is produced that may be exchanged at a physical location for goods or services. One use of the invention is to purchase gift certificates, which may be printed out and given to individuals. In effect, the invention allows virtual transactions to be turned into real transactions by means of an issued certificate.

In view of the foregoing, Applicant is of the opinion that the Examiner had failed to establish a *prima-facie* case of obviousness. In particular, there is no suggestion to combine the references in the manner described by the Examiner, there's no likelihood that one would expect the combination of references to result in a successful implementation of the claimed invention, and the references themselves are lacking in significant elements of the invention, in particular, the notion of a virtual certificate and an issued certificate.

Application Serial No. 09/472,100

Accordingly, the Applicant earnestly solicits the Examiner's reconsideration of the rejection and allowance of the application. Should the Examiner deem it helpful, he is encouraged to contact Applicant's attorney, Michael A. Glenn, at 650-474-8400.

Respectfully submitted,



Michael A. Glenn
Reg. No. 30,176

Customer No. 22862